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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,321	08/25/2000	SATOSHI KOIZUMI	5.1183	3262
5514	7590	11/19/2003	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			RAO, MANJUNATH N	
			ART UNIT	PAPER NUMBER
			1652	

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/645,321

Applicant(s)

KOIZUMI ET AL.

Examiner

Manjunath N. Rao, Ph.D.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Claims 4-22 are currently pending and are present for examination.

Applicant's amendments and arguments filed on 8-21-03, have been fully considered and are deemed to be persuasive to overcome the rejections previously applied. Rejections and/or objections not reiterated from previous Office actions are hereby withdrawn.

In the remarks section, applicant appears to have made an issue of the previous rejection of claims under 35 U.S.C. 112, 2<sup>nd</sup> paragraph for the recitation of the phrase "derived from". (See remark on page 14). In view of the claim amendments submitted by the applicant Examiner has withdrawn said rejection.

However, Examiner would like to reiterate that he has examined the claims with a broad interpretation of the terms used in the claims as expected of him by the Office. The conclusion reached by the Examiner in this regard is neither "anathema to the art accepted meaning of the language" nor contrary "to the conventional dictionary definitions of the same". In order to educate the applicant in this regard Examiner has included a copy of the page from the Webster's dictionary which provides the different meanings of the term "derived (from)" one of which is "to produce or obtain (a compound) from another substance by chemical reaction".

### ***Claim Objections***

Claim 4 is objected to because of the following informalities: Claim 4 recites the phrase "the group consisting of" twice in line 11. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, 17-22 and claims 6-16 which depend therefrom are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4, 5, 17-22 recite the phrase “treated matter of the culture” or “treated matter thereof”. However, said claims do not recite that the treated matter continues to have said enzymatic activities of the cultures rendering it indefinite. Examiner suggests applicants to recite the phrase “wherein said treated matter continues to have said enzymatic activity/ies” or the like appropriately in the above claims in order to overcome the above rejection.

***Conclusion***


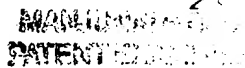
None of the claims are allowable.

Examiner has withdrawn the previous rejections of claim set 4, 6-16 and 19-22 and claim set 5-18, 21-22 as obvious under 35 U.S.C. 103(a) in view of the explanation provided by the applicants as to how the annotated epimerase enzyme of Baker et al. is different from the *Synechocystis* epimerase claimed in the instant claims.

In order to expedite the prosecution of this application, Examiner proposed claim amendments to overcome the above objection and rejection and faxed the same to the applicant for a response. However, as the applicant did not respond to the proposed amendments in time, Examiner has issued the above Office action.

Art Unit: 1652

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath Rao whose telephone number is (703) 306-5681. The Examiner can normally be reached on M-F from 7:30 a.m. to 4:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, P.Achutamurthy, can be reached on (703) 308-3804. The fax number for Official Papers to Technology Center 1600 is (703) 305-3014. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Manjunath N. Rao. Ph.D.  
November 14, 2003